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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,920	10/27/2000	Daryl S Meredith	0275A0168DVB	8371

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Harness Dickey & Pierce PLC
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Bloomfield Hills, MI 48303

EXAMINER

PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,920

Applicant(s)

MEREDITH ET AL.

Examiner

Kenneth E Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-44, 47-49 and 59-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-44, 47-49, 59-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 39-44,47-49,59-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Page 12 of Applicant's specification state that the arbor shaft cover prevents the fastener from vibrating off, but it is not clear how this is done. Based on figure 13a, which shows the arbor shaft cover, and figure 8, which shows the fastener, it appears that there *is* room for the fastener to vibrate off.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arbor shaft cover prohibiting the removal of the fastener must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 39-44 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault et al.'042 in view of Cotton et al.'022.

Brault shows a miter saw with most of the recited limitations including a fixed guard, a movable guard and an arbor shaft cover as best seen in figure 1. An operator is generally prohibited from removing the blade fastener (figure 1) from the shaft when the arbor shaft cover is in place.

It appears that Brault's arbor shaft cover may be pivoted out the way to expose the arbor shaft, but this is not entirely clear. However, Cotton shows that it is well known to employ an arbor shaft cover (6). It would have been obvious to one of ordinary skill in the art to have modified Brault, if necessary, by using the arbor shaft

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cover taught by Cotton, in order to protect the operator from the spinning shaft while permitting easy access to the shaft.

Brault's movable guard is on the inside of the fixed guard, as opposed to the outside. Whether the movable guard is on the inside or outside of the fixed guard is a simple reversal of parts obvious to one of ordinary skill. Furthermore, Examiner takes Official Notice that it is well known to have the movable guard on the outside. Examples of such can be seen in Sasaki et al.'516 and Brickner et al.'902, and additional examples can be provided if needed. It would have been obvious to one of ordinary skill in the art to have had Brault's movable guard be on the outside of the fixed guard, since this is a simple reversal of parts that would not change the operation of the device, and since it is old and well known, and since this is deemed to be an art recognized equivalent known for the same purpose, as per MPEP 2144.06.

In regards to claims 47-49, it is noted that Brault's miter saw is not a compound miter saw having a sliding drive support. However, Examiner takes Official Notice that both miter saws and compound miter saws generally use the same type of guards. Some examples of compound miter saws are the patents to Sato et al.'142 and Sasaki et al.'516, and additional examples can be provided if needed. It would have been obvious to one of ordinary skill in the art to have transformed Brault's miter saw into compound miter saw, or to have modified an existing compound miter saw to have Brault's modified guard, since miter saws and compound miter saws have interchangeable guard technology. The motivation for making such modifications is to be able to cut wider workpieces, a capability inherent in compound miter saws.

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5. Claims 59-67 would be allowable if the 112 rejection is overcome and the claims are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner notes that Brault et al. '042. does not show the interior of his guard, and thus there is no way to tell if the fasteners extend past the inner surface of the guard. Due to confidentiality of this application, and also due to limited resources, Examiner cannot contact Milwaukee tools and find out if their miter saws from the Brault et al.'042 era did or did not have their fasteners extend into the guard cavity. However, it is suggested that Applicant research this point, to avoid potential conflicts down the road. If Applicant is aware of further information about this, or becomes aware of it, he is required to submit this information in the next action.

6. Applicant's arguments have been fully considered but they are not persuasive.

Applicant's amendment, which recites "removal" of the fastener, is not commensurate in scope with his arguments, which discuss the fastener vibrating loose. It is clear from Brault's figure 1 that an operator is generally prohibited from removing the fastener when the arbor shaft cover is in place. The same goes for Cotton. There would be no reason to have arbor shaft covers, other than to gain access to an otherwise prohibited fastener. The question of whether or not Brault or Cotton could stop a vibrating nut from falling off is not germane, since that is not clearly claimed, and

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furthermore, it is not entirely clear what structure Applicant has for performing this function (see 112 rejection above).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp
November 18, 2004



KENNETH E. PETERSON
PRIMARY EXAMINER